

REMARKS

Claims 1, 3-5, and 8-20 are pending.

Claims 1, 7, and 10 are independent claims.

Information Disclosure Statement

An Information Disclosure Statement was filed but an initialed Form PTO-1449 was not received. The Examiner is requested to supply the missing Form PTO-1449 with the initials indicating that the documents filed have been considered. The Information Disclosure Statement was filed December 27, 2000.

Foreign Priority

There was no indication that the foreign priority documents were received. The foreign priority documents were submitted to the Patent Office on February 9, 2001. The Examiner is requested to indicate that these documents have been received.

Amendment to the Specification

The specification has been amended to correct a spelling error. Also, the title has been changed to be more consistent with US practice.

The Examiner is requested to review and enter the changes to the specification.

Reply to the Rejections

First Rejection - Claims 1-9 were rejected under 35 USC §102(b) as being anticipated by Goldhaber et al. (USP 5,794,210). This rejection as to the remaining claims is traversed.

Initially the Examiner's detailed review of the reference and citation of the portions of the reference relied on is appreciated and expedites prosecution.

Claim 1 has been amended by incorporating the subject matter of dependent claim 2. In amended claim 1 there is the following structure which at least is not shown in the reference either specifically or inherently.

...electronic advertisement storage control means for storing said electronic advertisement received by said electronic advertisement receiving means, when said identifying information does not match said identifying information of each of said at least one electronic advertisement stored in said electronic advertisement storing means.

While it is understood that in treating the reference Goldhaber et al. the Office Action has relied on column 16, lines 25-40 with the assertion that this shows what has been claimed in the last paragraph of claim 1 (amended). But column 16, lines 25-40 states as follows:

Brokerage server to look for matches between its consumer's interest profile 124 and indexed demographic information corresponding to the ads maintained by the attention brokerage server (Fig. 11A, block 184). The software agent 110 and/or the attention brokerage server 106 may remove from the list of matches all ads that the consumer has already

viewed (or has viewed within a particular time frame) (Fig. 11A, block 186). The software agent 100 may then return to the consumer's computer 104 with a file of thumbnail file on the consumer's computer 104 along with CyberCoin icons 62. Selecting the associated CyberCoin icon 62 initiates an interaction between the consumer's computer 104 and the attention brokerage server 106 that stores the matching ad (see below). (Emphasis Added)

Clearly what is shown in the reference is that the ads that the viewer has already seen are not listed. But amended claim 1 is quite different because the electronic advertising storage controls means stores only those identifying information that does not match identifying information that has previously been stored.

Accordingly, as each and every limitation of the claims is not shown either specifically or inherently in the reference, a rejection under 35 USC §102 is not valid.

Even if it were a possibility or probability from the reference, which it is not, a rejection under 35 USC §102 cannot be based on possibility or probability. See *Continental Can Co. USA, Inc. v. Monsanto*, 20 USPQ 2d, 1746, 1749, 1750 (Fed. Circ. 1991) which stated as follows:

To serve as anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled...[such] that the missing... matter is necessarily present in the ... reference, and that it would be so recognized by persons of ordinary skill ... "Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances I not sufficient..."

With respect to the dependent claims dependent on amended claim 1, these claims are considered patentable at least for the same reasons as their base claim.

Also, the features of claim 4 are not disclosed in column 17, lines 45-66 of Goldhaber, et al. cited in the Office Action.

With respect to independent claim 8, this claim has now been amended to include the structure of its base and intervening claims (claims 6 and 7). It is submitted that this structure is not shown either specifically or inherently in the reference applied. In fact, it does not appear from the Office Action that the Office Action has specifically identified wherein the reference this structure is disclosed.

With respect to claim 9, which is dependent on claim 8, this claim is considered patentable for at least the same reasons as its base claim.

For the reasons set forth the Examiner is requested to reconsider and withdrawal the rejection under 35 USC §102.

Second Rejection - Claims 10-15 were rejected under 35 USC §103(a) as being unpatentable over Goldhaber et al. as above. This rejection is traversed.

The Office Action at least correctly recognizes that Goldhaber et al does not show "response data... et al." It is the Examiner's position that this would have been obvious for the reasons set

forth in the rejection, but there is no evidence of this other than speculation on the Office Action which cannot be considered as viable evidence under 35 USC §103.

It appears what the Examiner's position is that one skilled in the art would be capable of doing what the Applicant has done. But capability does not equate to obviousness. *Ex parte Levengood* 28, USPQ 2d 1300 ((BPAI 1993)(also cited in the MPEP wherein the board stated as follows))

At best, the Examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at the Appellants invention because he had the necessary skills to carry out the requisite process. This is an inappropriate standard for obviousness. (Emphasis Added)

Also it would appear the Office Action may be asserting that this is basic knowledge to one skilled in the art. This also is not evidence. See *In re Zurko* 59USPQ2d 1693, 1697 (Fed. Cir. 2001). Also cited in the MPEP wherein the court stated as follows:

We cannot accept these findings by the Board. This assessment of basic knowledge... was not based on any evidence in record, and, therefore, lack substantial evidence support.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 USC §103.